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**OCT 12 2004**

**OFFICE OF PETITIONS**

In re Application of	:	
Thomas Ying and	:	
Peter Cudmore	:	
Application No. 10/742,150	:	DECISION REFUSING STATUS
Filed: December 18, 2003	:	UNDER 37 C.F.R. § 1.47(a)
Title: METHOD OF AND APPARATUS FOR	:	
RECOVERING A REFERENCE CLOCK	:	
Attorney Docket No. 6770P007	:	

This is in response to the "PETITION UNDER 37 C.F.R. § 1.47(a)," filed September 2, 2004.

The petition is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on December 18, 2003, with an unexecuted declaration. Accordingly, on April 1, 2004, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed the instant petition; the late surcharge under § 1.16(e); along with a declaration executed by inventor Thomas Man Yin Ying on behalf of himself and on behalf of non-signing inventor Peter Wayne Cudmore. This response was made timely by an accompanying petition (and fee) for extension of time for response within the fourth month. Applicant asserts that status under § 1.47(a) is proper because joint inventor Cudmore refuses to join in an application for patent or cannot be found after diligent effort.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. The instant petition does not satisfy requirement (1).

By declaration of patent attorney John Robinson, petitioner details attempts to contact inventor Cudmore by sending the declaration and power of attorney to the company he believed to be inventor Cudmore's employer and to inventor Cudmore's last known address. The company responded that the inventor no longer worked there and they did not have a forwarding email address. The attempts shown to locate or reach inventor Cudmore are not sufficient to show diligent effort. There is no indication that Rule 47 applicant attempted to determine the inventors' forwarding addresses from a postal service or through public records, and to send the application papers to any address obtained for consideration by inventor Cudmore. See MPEP 409.03(d).

If further attempts to obtain a forwarding address or to locate the non-signing inventor by other means such as through E-mail, telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37 C.F.R. § 1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicants should submit documentary evidence such as the results of any E-mail or Internet searches.

Of course, if inventor Cudmore is located, then a showing of presentation to him of the entire application package, including specification, claims and drawings, and his subsequent refusal is required for status under § 1.47(a).

Alternatively, petitioner has not shown that, by his conduct in failing to reply to the request to sign the declaration, inventor Cudmore has refused to join in the application. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d). The evidence only supports a conclusion that attempts to present the declaration and assignment papers to inventor Cudmore were made. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Further correspondence with respect to this decision should be addressed as follows:

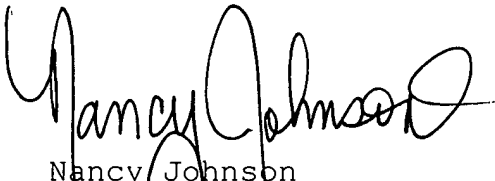
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Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson", with a stylized, cursive script.

Nancy Johnson  
Senior Petitions Attorney  
Office of Petitions